

R E M A R K S

Claims 1-23 are pending. Claims 1, 10, 13, 16, 19, and 23 are amended. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated March 23, 2007, the examiner rejected claims 1-9, 13-15, and 19-22 under 35 U.S.C. §102(b) as being anticipated by the publication of Vines, entitled "How to save your files and your sanity" (Vines). The examiner withdrew the previous holding of the allowability of claims 10-12, 16-18, and 23 (if rewritten in independent form) and rejected claims 10-12, 16-18, and 23 under 35 U.S.C. §103(a) as being unpatentable over Vines in view of Kanai et al, U.S. Patent Publication No. 2002/0152181 A1 (Kanai).

Re the Claims:

Claims 1, 10, 13, 16, 19, and 23 are amended to clarify that the list of media to be loaded into a plurality of backup devices includes at least one medium to be loaded into a first backup device and at least a second medium to be loaded into a second backup device.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102 and 103

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

The test for obviousness under 35 U.S.C. § 103 is whether

the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. In re Donovan, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. In re Rinehart, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. In re Meng, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. In re Lintner, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Put somewhat differently, the fact that the inventions of the references and of the applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (1966).

Re the Section 102 Rejections:

The examiner rejected claims 1-9, 13-15, and 19-22 under 35 U.S.C. §102(b) as being anticipated by Vines. These rejections are improper in that Vines does not meet the limitations of the rejected claims. Consequently, Vines cannot anticipate any of the rejected claims.

In responding to applicants' previous arguments, the examiner takes the position that the disclosure of Vines is sufficiently broad so as to be encompassed by the pending claims, as detailed in Sections 5-7 of the office action. Applicants disagree that the Vines disclosure is so broad. The Vines reference is a mere tutorial on how to save files on a Windows-based operating system. Vines does not discuss any aspects of a file backup procedure, much less discuss different types of backup devices, backup media, or a media manager.

In rejecting the claims, the examiner asserts that the files referenced in Vines can be considered "a list of a single medium of conveyance." The first problem with this assertion is that the claims nowhere use the language "a list of a single medium of conveyance," so the examiner's rationale is erroneously directed to language that is not in the claims. While the Vines reference mentions "files," those files are not a "list of media" within the context of the present invention. Even if Vines' files are regarded as a list of media, Vines fails to disclose the following limitations of the claims, which are key in distinguishing them from the Vines reference.

For example, amended claim 1 is directed to a method that involves 3 elements or steps: 1) "Receiving a list of media to be loaded into a plurality of backup devices. . .;" 2) "ordering the list by physical location of the backup devices;" and 3) "presenting the ordered list to a user." While a "list of media" may be regarded as a file, the examiner has failed to point out where Vines discloses (or even suggests) that such a list could be ordered "by physical location of the backup devices" and then "presenting" that list "to a user."

5 The examiner argues, in Section 10, that because the list
in Vines is of length 1, it is "inherently ordered by any measure
of ordering." The first problem with the examiner's argument is
that the "list of media" of claim 1 involves more than a list of
"length 1" because the term "media" is plural, not singular.
Again, the examiner's rationale is erroneously based on language
that is not contained in the pending claims. Second, claim 1
requires the list of media (more than 1) to be loaded into a
"plurality of backup devices." While the Windows dialog box
10 presented in Vines gives the user several "drives" where the file
can be saved, it is the "file" as a whole that is saved, and that
file is saved in a single drive.

15 Stated another way, the plain language of amended claim 1
requires a list of more than one element (i.e., "media") that are
to be loaded into a "plurality" of backup devices, meaning that
at least one medium in the list may be loaded into a first backup
device, and at least a second medium in the list may be loaded
into a second backup device. Vines presents no such option.
Rather, the entire file (i.e., list) in Vines is what is saved
20 on the drive.

Element 2 of claim 1 involves "ordering the list by physical
location of the backup devices," which is nowhere disclosed in
Vines. That is, element 1 of claim 1 involves receipt of a list
of media that are to be loaded into a plurality of backup
25 devices. Once that list is received, it is ordered as required
by element 2. The examiner has not pointed to any portion of
Vines that discloses or suggests this ordering. While the
examiner states (in section 10) that "the list is length 1, so
it is inherently ordered by any measure of ordering," this
30 statement does not meet the limitations of claim 1, wherein the
"list of media" comprises more than one element. That is, claim
1 does not involve the trivial case of a list of length 1. The
fact that Vines discloses no "ordering" cannot be cured by
arguing that Vines discloses a list of 1 and that the list of 1
35 is inherently "ordered."

The fact remains that Vines is nothing more than a simple tutorial on how to save document files in a Windows format. Vines is not concerned with data backup procedures and does not disclose (or even suggest) a system that involves a plurality of backup devices (such as disk or tape drives), much less the problems associated with backing up data to multiple drives located in multiple physical locations. Because Vines is not concerned at all with data backup operations, Vines cannot be said to "order" a list by the physical location of the backup devices. Accordingly, Vines cannot anticipate claim 1.

Dependent claims 2-9 are at least allowable over Vines because they depend from claim 1, which is allowable over Vines.

* * *

Independent claim 13 is also allowable over Vines because Vines fails to meet several of the elements and limitations contained in claim 13. For example, claim 13 requires a planner that receives a list of media to be loaded into a plurality of backup devices. However, Vines' files are not a list of media within the context of the present invention, nor does Vines even suggest that the files might involve a list of media. Moreover, even if Vines' files are regarded as a list of media, nowhere does Vines disclose a planner that orders the list "by physical location of the backup devices."

Vines does not disclose any backup devices at all, much less discuss anything about the physical locations of such backup devices. While the examiner asserts that Vines' drives might be backup devices, it is unreasonable to make such an assertion in the context of the teachings of the Vines reference. Vines' drives simply represent the device that stores the files in the first place, they are not backup devices as the term is understood by persons having ordinary skill in the art.

Of course, Vines also fails to disclose a planner that orders the list by physical location of the backup devices. This deficiency cannot be excused by arguing that Vines may disclose

the trivial case of an ordering of a "list of length 1." Because Vines fails to disclose at least these elements and limitations of claim 13, Vines cannot anticipate claim 13.

Dependent claims 14 and 15 are at least allowable over Vines because they depend from claim 13, which is allowable over Vines.

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Independent claim 19 is allowable over Vines because Vines does not disclose "receiving a list of media to be loaded into a plurality of backup devices." As mentioned above, it is not reasonable to construe the files of Vines as being "list of media" as contemplated by claim 19. Vines says nothing about backup operations in general and certainly does not disclose anything that could be reasonably construed as a backup device.

Claim 19 also requires "ordering the list by physical location of the backup devices." Of course, Vines fails to disclose a backup device, any issues associated with differing physical locations of such backup devices, or ordering the list by physical location of the backup devices. The examiner's assertion that Vines discloses the trivial case of ordering a "list of length 1" is insufficient to overcome the fact that Vines fails to meet this limitation. Therefore, because Vines fails to disclose at least these elements and limitations of claim 19, Vines cannot anticipate claim 19.

Dependent claims 20-22 are at least allowable over Vines because they depend from claim 19, which is allowable over Vines.

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Re the Section 103 Rejections:

The examiner rejected claims 10-12, 16-18, and 23 under U.S.C. §103(a) as being obvious over Vines and Kanai. These rejections are improper in that neither reference contains the

suggestion or incentive that would be required to combine the references in the manner required by the pending claims. Moreover, even if it were proper to combines the references, which is denied, the resulting combination would still fail to meet the limitations of the pending claims. Consequently, neither Vines nor Kanai, taken alone or in combination, can establish the required prima-facie case of obviousness of claims 10-12, 16-18, and 23.

As discussed at length above, Vines is nothing more than a tutorial on how to save document files in a Windows environment. Vines does not discuss any aspects of a file backup procedure, different types of backup devices, backup media that are to be loaded into such backup devices, or problems associated with the management of the backup process. While the Kanai reference discloses a rental storage system and a service method for a rental storage system, the examiner has failed to identify the specific teachings in either reference that would motivate a person having ordinary skill in the art, and with no knowledge of the present invention, to combine the references in the manner required by the pending claims. Indeed, no such teachings exist because the two references are directed to different issues.

While the examiner attempts to justify the combination of the two references by stating that they "both have to do with user management of storing files" (section 21), all the examiner has really done is to use the claims as a blueprint for combining the references. Vines is a tutorial on how to save files in a Windows-based environment. Kanai discloses a system and method for allowing users to rent storage space to store files at a remote location via a network connection. Vines does not discuss the need to store files at an off-site location, much less whether such storage would be by rental or by purchase. Kanai is not troubled by the simple problem of saving document files in a Windows-based environment. Because the examiner has failed to identify where the suggestion or motivation would come from to combine Vines with Kanai, the examiner has failed to establish

the required prima-facie case of obviousness.

5 However, even if it were proper to combine Vines with Kanai, which is denied, the resulting combination would still fail to meet the limitations of the pending claims. For example, claim 10, as amended, requires "receiving a list of media. . ." and "ordering the list by physical location of the backup devices." Vines does not disclose any such ordering, except, as argued by the examiner, in the case of a "list of length 1," which is trivial and not really an ordering at all. Kanai also fails to
10 meet at least this limitation. Therefore, even if Vines and Kanai were combined, the resulting combination would still fail to meet the limitations of amended claim 10. Consequently, claim 10 is allowable over Vines and Kanai.

15 Dependent claims 11 and 12 are at least allowable over Vines and Kanai because they depend from claim 10, which is allowable over Vines and Kanai.

* * *

20 Independent claim 16 is also allowable over Vines and Kanai because, even if the references are combined, they still fail to meet several of the elements and limitations contained in claim 16. For example, claim 16 requires a planner that receives a list of media to be loaded into a plurality of backup devices. Vines' files are not a list of media within the context of the present invention, nor does Vines even suggest that the files
25 might involve a list of media. Moreover, even if Vines' files are regarded as a list of media, nowhere does Vines disclose a planner that orders the list "by physical location of the backup devices."

30 Vines does not disclose any backup devices at all, much less discuss anything about the physical locations of such backup devices. While the examiner asserts that Vines' drives might be

5 backup devices, it is unreasonable to make such an assertion in the context of the teachings of the Vines reference. Vines' drives simply represent the device that stores the files in the first place, they are not backup devices within the normal meaning of the term.

10 Vines also fails to disclose a planner that orders the list by physical location of the backup devices. This deficiency cannot be excused by arguing that Vines may disclose the trivial case of an ordering of a "list of length 1." Kanai also fails to disclose a planner that meets these limitations. Therefore, even if Vines is combined with Kanai, the resulting combination would still fail to meet at least these elements and limitations of claim 16. Therefore, claim 16 is not prima-facie obvious over Vines and Kanai.

15 Dependent claims 17 and 18 are at least allowable over Vines and Kanai because they depend from claim 16, which is allowable over Vines and Kanai.

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20 Independent claim 23 is not prima-facie obvious over Vines and Kanai because neither reference discloses "receiving a list of media to be loaded into a plurality of backup devices," and then "ordering the list by physical location of the backup devices." Of course, Vines fails to disclose a backup device, any issues associated with differing physical locations of such backup devices, or ordering the list by physical location of the backup devices. The examiner's assertion that Vines discloses the trivial case of ordering a "list of length 1" is insufficient to overcome the fact that Vines fails to meet this limitation. Kanai also fails to meet this ordering limitation. Therefore, claim 23 is not prima-facie obvious over Vines and Kanai.

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Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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